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CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

Henry C. Bunsow (SBN 60707)
bunsowh@howrey.com
Denise De Mory (SBN 168076)
demoryd@howrey.com
Brian A.E. Smith (SBN 188147)
smithbrian@howrey.com
HOWREY LLP
525 Market Street, Suite 3600
San Francisco California 94105
Telephone: (415) 848-4900
Facsimile: (415) 848-4999

Attorneys for Defendant
AuthenTec, Inc.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

ATMEL CORPORATION, a Delaware
corporation; ATMEL SWITZERLAND, a
corporation; ATMEL FRANCE, a corporation;
and ATMEL SARL, a corporation,

Plaintiffs,

v.

AUTHENTEC, INC., a Delaware corporation,
Defendant.

Case No. 06 CV 2138 CW

**REQUEST FOR INTERNATIONAL
JUDICIAL ASSISTANCE PURSUANT TO
THE HAGUE CONVENTION THE TAKING
OF EVIDENCE ABROAD IN CIVIL OR
COMMERCIAL MATTERS
(HAGUE CONVENTION #20)**

IDENTITY AND ADDRESS OF THE APPLICANT:

Honorable Elizabeth Laporte
United States District Court for the Northern District of California
San Francisco Division
Courtroom E, 15th Floor
450 Golden Gate Avenue
San Francisco, CA 94102

CENTRAL AUTHORITY OF THE RECEIVING STATE:

Ministero degli Affari Esteri
Directorate General for the Countries of the Americas
Piazzale della Farnesina, 1
00194 Roma
ITALY
Telephone: +39 06.36911

In conformity with Article 3 of Hague Convention #20, the undersigned applicant has the honor and judicial authority to submit this request on behalf of the Defendants in the above-entitled action.

The United States District Court, for the Northern District of California, by and through the Honorable Elizabeth Laporte, presents its compliments to the judicial authorities of Italy, and requests international judicial assistance to obtain evidence to be used in a civil proceeding before this court in the above-captioned matter.

A trial on this matter is currently scheduled to take place in California. This court requests the assistance described herein as necessary in the interests of justice.

Below are the names of all parties in this matter and their representatives:

Party	Legal Representative
PLAINTIFFS: Atmel Corporation Atmel Switzerland Atmel France Atmel SARL By and through counsel: Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000	Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000
DEFENDANTS: AuthenTec, Inc. AuthenTec By and through counsel: Denise De Mory, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900	Henry C. Bunsow, Esq. Denise De Mory, Esq. Brian A.E. Smith, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900 Fax (415) 848-4999

REPRESENTATIVE TO ACT ON BEHALF OF DEFENDANTS;

It is requested that should contact or correspondence with Defendants in this matter be required, the following individual is appointed in this matter to represent Defendants:

Denise De Mory, Esq.
 Howrey LLP
 525 Market Street, Suite 3600
 San Francisco, California, 94105
 United States of America
 Telephone (415) 848-4900
 Fax (415) 848-4999

1 **ENTITY FROM WHOM EVIDENCE IS REQUESTED:**

2 **University of Bologna**
 3 Cesena Campus
 4 via Genova, 181
 Cesena, Italy
 Telephone: +39.0547.339130

5 It is believed that **University of Bologna** is a business entity registered to do business in Italy.

6 **SUBJECT MATTER AND RELATIVITY OF THIS REQUEST:**

7 Atmel filed a complaint against AuthenTec, Inc. ("AuthenTec") in the United States District
 8 Court for the Northern District of California alleging patent infringement ("Atmel Lawsuit"). The two
 9 patents asserted against AuthenTec relate to fingerprint sensors. Based on documents that AuthenTec
 10 has received in this case, AuthenTec believes that the two patents asserted by Atmel may be invalid
 11 due to inventorship by another and/or an on sale bar. AuthenTec believes that evidence of prior
 12 inventorship and/or an on sale bar is in the possession, custody and control of **University of Bologna**,
 13 in part, because Atmel has produced documents authored by the inventor of the asserted patents
 14 referencing **University of Bologna**. The requested documents and information from **University of**
 15 **Bologna** are therefore relevant to and necessary for trial of this case.

16 **SPECIFIC REQUESTS:**

17 The District Court respectfully requests that these documents and information be produced
 18 quickly, but if at all possible within 30 days after receipt of this request, at a place and time designated
 19 by the Italian court having competent jurisdiction over this request.

20 In view of the foregoing, we therefore request, in the interest of justice, that you issue an order
 21 for the acquisition of the evidence requested below, in accordance with the laws and procedures of the
 22 courts of Italy, and summon the appropriate employee, director, officer or other appropriate
 23 representative of **University of Bologna**, in possession or control of the evidence requested, to submit
 24 the evidence requested to a duly appointed authority in Italy, in an expeditious manner, for
 25 examination by the below signed authority.

EVIDENCE TO BE OBTAINED:

A. Definitions.

In addition to the abbreviated terms identified above, for the purposes of this request:

(1) the terms “you” and “your” mean **University of Bologna**, including, without limitation, all predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf;

(2) the term “Thompson-CSF” means Thomson-CSF and all predecessors (merged, acquired, or otherwise) successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, including but not limited to IDmatics, Laboratoire Central de Recherches, and Thomson-CSF Semiconducteurs Specifiques, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf;

(3) the term “STMicroelectronics” means STMicroelectronics and all predecessors (merged, acquired, or otherwise) successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf;

(4) the term “Atmel” means Atmel Corporation, Atmel SARL, Atmel France, Atmel Switzerland, Atmel Grenoble and all predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf.

(5) the term “Thales” means the Thales Group and all predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf.

(6) the term “fingerprint sensor” means all mechanical, electronic, optical, electro-optical, capacitive, reflection, RF, pressure, temperature, ultrasound, and micro-electro-mechanical systems and devices designed to read a fingerprint for authenticating individuals, including but not limited to all prototypes and experiments related to such sensors and further including but not limited to strip and/or swipe sensors;

(7) the term “fingerprint sensing technologies” means all hardware, software, and other components that may be incorporated into or work in conjunction with a fingerprint sensor, including but not limited to electronic circuitry, microchips, elements, conductive layers, and algorithms, further including but not limited to image stitching algorithms;

(8) the word “document” includes any written, printed, typed, recorded, computerized, electronic, taped, graphic, or other matter, in whatever form, whether in final or draft, including but not limited to all materials that constitute “writings,” “recordings,” “photographs,” “source code” or “executable code” within the broadest meaning of Rule 1001 of the Federal Rules of Evidence and all materials that constitute “documents” within the broadest meaning of Rule 34 of the Federal Rules of Civil Procedure. The word “document” includes, without limitation, printed matter, electronic mail, materials stored on computer hard drives, diskettes, tapes, any other computer media, and any other information stored magnetically, optically or in any electronic medium and/or form;

(9) the term “communication” includes, without limitation, communications by whatever means transmitted (i.e., whether oral, written, electronic or other methods used), as well as any note, memorandum or other record thereof;

(10) the term “FingerChip” means the fingerprint sensor manufactured by the Atmel Corporation, including but not limited to the fingerprint sensing technologies developed by Jean-Francois Mainguet and incorporated into the FingerChip product.

B. Documents requested.

The District Court requests the production of the following documents, which are in the possession, custody, or control of **University of Bologna**:

1. Documents relating to or referring to a partnership between the **University of Bologna** and STMicroelectronics concerning fingerprint sensors and/or fingerprint sensing technologies.
2. Documents relating to or referring to United States Patent No. 6,289,114 (“the ’114 patent) or United States Patent No. 6,459,804 (“the ’804 patent”) titled “Fingerprint-Reading System.”
3. Documents relating to or referring to fingerprint sensors and/or fingerprint sensing technologies consisting of: (1) sensors with a surface area smaller than the surface area of a finger, and/or (2) combining partial fingerprint images to create a more complete fingerprint image, and/or (3)

1 collection of fingerprint data by movement of a finger over a fingerprint sensor, including but not
 2 limited to publications, articles, patents, patent applications, schematics, lab notebooks, and manuals.

3 4. Documents relating to or referring to communications prior to June 5, 1997 between you
 4 and Jean-Francois Mainguet, or any other person employed by or associated with Thomson-CSF,
 5 concerning fingerprint sensors and fingerprint sensing technologies, including but not limited to
 6 FingerChip.

7 5. Documents relating to or referring to communications between you and Thomson-CSF,
 8 Atmel, and/or Thales concerning licensing, offers to license, infringement, invalidity and/or that affect
 9 in any way rights related to the '804 patent and/or the '114 patent.

10 The documents and information requested above are for use as evidence in the Atmel Lawsuit,
 11 including for use at trial. This Court makes this request to secure production of documents and
 12 information from the **University of Bologna**, which resides in the jurisdiction of Italy, and this Court
 13 confirms that this is proper and necessary to request since it relates to AuthenTec's counterclaims and
 14 defenses and is necessary for a fair resolution of these issues at trial.

15 It is requested that should any portion of this request, or subject questions as described below,
 16 be denied on legal grounds, that such denial not affect the remainder of this request.

17 It is requested that any evidence produced be marked, attested, properly sealed by the
 18 appropriate authorities of Italy and returned through appropriate channels to the below signed
 19 authority.

20 Defendant AuthenTec, through counsel Howrey LLP (525 Market Street, Suite 3600, San
 21 Francisco, California 91405, United States of America, Telephone: (415) 848-4900), will reimburse
 22 the appropriate judicial authorities in Italy, for all costs incurred in executing the below signed judicial
 23 authority's request for international judicial assistance.

24 When required, the below signed judicial authority shall provide reciprocal assistance, such as
 25 requested herein, to the appropriate judicial authorities of Italy.

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1 The United States District Court for the Northern District of California extends the assurance of
2 its highest consideration to the judicial authorities of Italy.

3 Date of Request: Sept 14, 2007.

4
5 By: 
6 HON. ELIZABETH LAPORTE
7 UNITED STATES DISTRICT COURT JUDGE
8 United States District Court
9 Northern District of California
10 San Francisco Division
11 Courtroom E, 15th Floor
12 450 Golden Gate Avenue
13 San Francisco, CA 94102

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